

REMARKS**A. INTRODUCTION**

Claims 1-3, 5-21, 23-44 and 46 – 167 are pending and rejected.

Claims 4, 22 and 45 were previously cancelled.

Claims 75-86, 88-93, 96-143 and 154 – 161 are withdrawn from consideration.

The rejections of Claims 1-3, 5-21, 23-44, 46-74, 87, 94, 95, 144-153 and 162 – 167 were under appeal. Applicants are requesting under 37 CFR § 41.39(b)(1) that prosecution be reopened in light of the new grounds of rejection under Section 101 provided in the Examiner's Answer.

Upon entry of this Amendment:

- Claims 1-3, 5-21, 23-44 and 46 – 165 will be pending
- Claims 1, 48, 58, 87 and 162-165 will be amended
- Claims 75-86, 88-93, 96-143 and 154 – 161 will remain withdrawn
- Claims 166 and 167 will be cancelled without prejudice

B. SECTION 101 REJECTION

Claims 1-87 and 162-167 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. We respectfully traverse the Examiner's Section 101 rejection.

Applicants first respectfully note that not all of Claims 1-87 have been examined previously, though they are all summarily rejected under Section 101 in the Examiner's Answer. Claims 75-86, for example, are rejected although they are withdrawn and were not under appeal. Further, Claims 81-85 are not directed to method claims.

Accordingly, Applicants assume that the Examiner intended to address only the rejected method claims under appeal and currently subject to examination on the merits, which include only Claims 1-3, 5-21, 23-44, 46-74, 87 and 162 – 167. Claims 166 and 167 are now cancelled.

Each of independent method claims 1, 48, 58, 87, 162, 163, 164 and 165 has been amended in order to recite particular respective embodiments in which particular functional limitations of the methods are tied to a particular apparatus, such as one or more of a coupon offer issuer server, coupon recipient device or coupon offer provider server.

Accordingly, Applicants respectfully request the Examiner's reconsideration and withdrawal of the Section 101 rejections of Claims 1-3, 5-21, 23-44, 46-74, 87 and 162 – 165.

C. SECTION 103(A) REJECTIONS

Claims 1-3, 5-21, 23-44, 46-74, 87, 94-95, 144-153 and 162-167 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (U.S. Patent No. 5,368,129), and further in view of “How MileNet Works”. We respectfully traverse the Examiner's Section 103(a) rejection.

Applicants refer the Examiner to the preceding Appeal Brief and Reply Brief, which are incorporated herein by reference to address the Section 103(a) rejections maintained by the Examiner. Some additional remarks follow.

The Examiner notes that Official Notice has been taken that:

it is old and well known, in chain referral sales, multi-level business pyramids or the like for a seller to induce a buyer to purchase merchandise by promising to give the buyer a discount or a rebate if the buyer furnishes the seller with the names of other prospective buyers. In certain cases, the rebate is paid only if the buyer actually makes a purchase. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included updating benefit of said coupon in association with a first recipient of said coupon and said qualifying action is associated with a second recipient of said coupon, wherein said second recipient is a downstream recipient of said first recipient; providing an indication to said first recipient of a completion of said qualifying action by said second recipient in order to obtain the above mentioned advantage.

In addition to the challenge of the Official Notice taken above, the Examiner has cited MileNet to support the Official Notice. MileNet teaches a pyramid type of incentive wherein the user will increase their MileNet points based on having friends and family install and use MileNet. The use and installation of MileNet works as the downstream of the coupon.

[Examiner's Answer, page 5].

Applicant respectfully traverses this attempted use of Official Notice as improper. Consequently, a necessary element of a *prima facie* case is absent.

Firstly, it is to be appreciated that the Office Action attempts to officially notice legal conclusions; namely, it would have been obvious to a person of ordinary skill in the art to utilize somehow “chain referral sales, multi-level business pyramids or the like to provide for all of the subject matter the Examiner

acknowledges is missing from Von Kohorn. Official Notice, however, is only proper for facts. (*MPEP* § 2144.03). Indeed, Official Notice is only permissible for those few facts that are of a “notorious character” and that are “capable of instant and unquestionable demonstration”. (*MPEP* § 2144.03(A)). It is improper to use Official Notice for conclusions of law.

Secondly, the Office Action relies on Official Notice as the “principal evidence” upon which the rejection of claim 1 is based. Official Notice cannot be used in this manner. As Section 2144.03(A) of the *MPEP* expressly warns, it is never appropriate to rely solely on Official Notice as the principal evidence upon which a rejection was based. Instead, Official Notice is only appropriate for facts that serve to “fill in the gaps” in a rejection. (*MPEP* § 2144.03(A)). This is why official notice is to be judicially applied. (*MPEP* § 2144.03). It is unreasonable to conclude that the Office has used Official Notice to “fill in” an acknowledged gap in Von Kohorn in this rejection.

Thirdly, the Office attempts to take Official Notice of matter that is not “capable of instant and unquestionable demonstration”, as expressly required by section 2144.03(A) of the *MPEP*. Indeed, even assuming *arguendo* that the equivalence of the subject printer and plotter is a fact, this fact would be neither of notorious character nor instantly and unquestionably demonstrable. Moreover, courts have long rejected the notion that official notice can be taken on the state of the art. (See *Memorandum to Patent Examining Corps from the Deputy Commissioner for Patent Examining Policy regarding Procedures for Relying on Facts Which are Not of Record as Common Sense or for Taking Official Notice*, n.6, citing *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973)). Thus, the Office’s attempt to officially notice the level of ordinary skill in the art is improper as a matter of law.

In sum, the Office’s attempts at Official Notice are improper and traversed. Consequently, there are evidentiary gaps in the rejection of the independent claims that are fatal to a *prima facie* case of obviousness.

Further, the Examiner alleges that MileNet supports the Official Notice. Applicants respectfully disagree. MileNet does not provide evidence of what the Examiner alleges is “old and well known”: promising to give a buyer a discount or rebate if the buyer furnishes the seller of the names of other prospective buyers. To the contrary, the software, as described is “completely free for our users” (emphasis added). Accordingly, MileNet is not evidence supporting the Examiner’s assertion that “chain referral sales” were known, and in fact teaches only referral of free software. Accordingly, MileNet does not support, but rather contradicts the Examiner’s Official Notice. As the Examiner’s grounds of

rejection on the finding that “chain referral sales” teach subject matter not taught by Von Kohorn, and the only evidence cited in support of that finding teaches away from “sales,” Applicants submit that no prima facie case of obviousness has been established for any of the Section 103(a) rejections of Claims 1-3, 5-21, 23-44 and 46 – 165.

D. ADDITIONAL COMMENTS

Our silence with respect to the Examiner’s other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner’s interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner’s assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

E. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

Applicants do not believe that any fees are necessary for this response.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Deposit Account: 50-0271

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Please credit any overpayment to the same account.

F. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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